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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,689	09/26/2001	Mark Stewart Nichols	05222.00 163	3228

29638 7590 10/23/2003

BANNER & WITCOFF AND ATTORNEYS FOR ACCENTURE
10 S. WACKER DRIVE, 30TH FLOOR
CHICAGO, IL 60606

EXAMINER

HIRL, JOSEPH P

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 10/23/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

PR4

Office Action Summary	Application No.	Applicant(s)	
	09/868,689	NICHOLS ET AL.	
	Examiner	Art Unit	
	Joseph P. Hirl	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-18 are pending in this action.
2. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.
3. The Examiner has taken notice of the statement in the Information Disclosure Statement at page 1, lines 19-24, that the information on the Protest related to Application 09/219,478 does not apply to the instant application and that further, the individuals serving protest, have no basis for a protest in the instant application. By oath of the inventors, no other inventors were responsible for the instant application.

Information Disclosure Statement

4. The information disclosure statement filed February 7, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because copies of each listed reference has not been provided with this application and there is no statement that the application related to a prior IDS filing has any relevance to an earlier filing date of the instant application. Further, from the MPEP at page 600-118, col 1: "Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search." If the applicant wishes to submit the related documents, it will be necessary to provide a short statement with each one justifying why it should be in the proper field of search (i.e. relevant to the application). The IDS has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C (1).

Drawing Objections

5. The drawings are objected to because of the following:

All PCT references should be removed.

These objections must be corrected.

Specification Objections

6. The specification is objected to because of the following:

The disclosure must be in full compliance with 37 CFR 1.51 and 1.52.

Specifically, all font must be at least .21 cm high.

No abstract was provided.

These objections must be corrected.

Claim Objections

7. The Claims are objected to because of the following:

Claim 10 is missing step (a).

These objections must be corrected.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown (US Patent 6, 210, 272, referred to as **Brown**).

Claim 1

Brown anticipates a) receiving indicia representative of a goal (**Brown**, Figs. 2-A, 2-B); (b) integrating examples into the presentation to provide assistance with achieving the goal (**Brown**, c 5, l 44-53); (c) monitoring progress of a student toward the goal and providing feedback that further assists the student in accomplishing the goal (**Brown**, c 6, l 8-11); and (d) providing a linkage to a website of information to assist with achieving the goal (**Brown**, c 7, l 38-63).

Claims 2, 11

Brown anticipates the website comprises a plurality of HTML documents (**Brown**, c 7, l 38-63; Examiner's Note (EN): to one of ordinary skill in the art, HTML documents are ASCII files which are distributed among user computers and the server in a network architecture).

Claims 3, 12

Brown anticipates a relational database of information (**Brown**, c 7, l 38-63; EN: to one of ordinary skill in the art, a relational database is a database that is organized and accessed according to relationships between data items).

Claims 4, 13

Brown anticipates the website is keyword indexed (**Brown**, c 5, l 29-33).

Claims 5, 14

Brown anticipates the website includes linkages to the presentation (**Brown**, c 7, l 38-63).

Claims 6, 15

Brown anticipates the website includes navigation information for the presentation (**Brown**, c 5, l 29-33; EN: navigation is synonymous with a treed selection).

Claims 7, 16

Brown anticipates the website is indexed in a hierarchical manner (**Brown**, c 5, l 29-33; EN: the decision listing is a form of an indexed hierarchy) .

Claims 8, 17

Brown anticipates the website includes presentations on related presentation information (**Brown**, c 5, l 29-33; EN: the presentation information is the listing).

Claims 9, 18

Brown anticipates the website information is based on the presentation context (**Brown**, c 5, l 29-53; c 7, l 38-63).

Claim 10

Brown anticipates (b) a processor (**Brown**, c 7, l 38-63); (c) a memory that stores information under the control of the processor (**Brown**, c 7, l 38-63) ; (d) logic that integrates examples into the presentation to provide assistance with achieving the goal (**Brown**, c 5, l 44-53); (e) logic that monitors progress of a student toward the goal and provides feedback that further provides the student assistance in accomplishing the goal (**Brown**, c 6, l 8-11); and (f) logic that provides a linkage to a website of information to assist with achieving the goal (**Brown**, c 7, l 38-63).

Conclusion

10. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

Morris et al, US Patent 6,075,968

Horvitz et al, US Patent 6, 262,730

Lamson, US Patent 6,425,764

Burna, US Patent 5,904,484

11. Claims 1-18 are rejected.

Correspondence Information

12. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anil Khatri can be reached at (703) 305-0282.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II

2121 Crystal Drive,

Arlington, Virginia.

Joseph P. Hirl

Ramesh Patel
RAMESH PATEL 10/17/03
PRIMARY EXAMINER
For Anil Khatri

October 16, 2003